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In re Application of
Theoharis C. Theoharides
Serial No.: 10/811,828
Filed : March 20, 2004
Attorney Ref No.: 51275/149

Decision on Petition

This letter is in response to the Petition under 37 C.F.R. 1.144, filed on October 9, 2006, to request review of the requirement for restriction made final in the referenced application and request that that restriction requirement be withdrawn.

BACKGROUND

A review of the file history shows that the application was filed on March 20, 2004 with claims 40 to 45.

On May 4, 2006, a requirement under 35 U.S.C. 121, to elect a single disclosed species from each of the genera of flavonoid and proteoglycan was made from claims 40 to 44.

On June 21, 2006, applicant provisionally elected quercetin and chondroitin sulfate with traverse. However, applicant also pointed out that claim 45 was not referred to in the restriction requirement of May 4, 2006.

On June 29, 2006, the examiner mailed a supplemental restriction requirement under 35 U.S.C. 121, clarifying the record and requiring applicant to elect a single disclosed species from claims 40 to 45.

On August 28, 2006, the restriction requirement was deemed proper and made final and a first action was mailed to applicants. Claims 40 to 45 were rejected on the grounds of nonstatutory double patenting, claims 40 to 45 were rejected under 35 U.S. C. 112 first paragraph, and claims 40 to 43 and 45 were rejected under 35 U.S.C. 103(a) as unpatentable over Ronca et al. in view of Gelber et al. in view of Noblie et al. in view of Sang.

On October 9, 2006, applicant filed the petition discussed herein.

DISCUSSION

Applicant's petition under 37 C.F.R. 1.144, was filed on October 9, 2006, to request review of the requirement for restriction made final in the referenced application and request that that requirement to elect a species be withdrawn.

Applicant argues that, contrary to the examiner's assertion, all flavonoids have the same basic three-ring structure and that the flavonoid species listed in claim 42 are merely claimed members of the same family and differ only in relative strength.

Applicant also argues that that examiner has improperly ruled that the heavily sulfated proteoglycan component of claim 40 is too broad. Applicant argues that the chondroitin sulfate is merely one of a family of molecules more accurately called "glycosaminoglycans" because one of the two sugars is always an amino sugar and that all sulfated proteoglycans are generally known in the art to exhibit similar properties.

Applicant's argument is acknowledged and has been carefully considered, however, it is found not persuasive on the following basis.

Applicant apparently does not understand election of species practice, which is the only thing that the examiner has used. Even if the flavonoids have a common core structure (which they apparently do not), they do have different structures, and different functions/effects even if only by having different relative strengths. That is the essence of species. Also, applicant should understand that if the elected species is allowable, then the search will extend to non-elected species so applicant will not necessarily be precluded from getting an examination on the additional species.

Regarding proteoglycans, applicant's argument seems to be directed to a 112, 1st rejection and not to the election of species requirement, and thus, is also not persuasive.

DECISION

For these reasons, the Petition under 37 C.F.R. 1.144, filed on October 9, 2006, to request that the election of a single species from each of the genera of flavonoid and proteoglycan be withdrawn is **DENIED**.

Applicant remains under obligation to properly reply to the non-final Office action mailed August 28, 2006, within the time period set therein or as extended under 1.136 (a).

Any request for reconsideration of this petition decision must be filed within two (2) months of the mailing date of this decision.

Should there be any questions regarding this decision, please contact Special Program Examiner Marianne C. Seidel, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-872-9306.

A handwritten signature in black ink, appearing to read 'Bruce Kisliuk', with a stylized flourish at the end.

Bruce Kisliuk
Director, Technology Center 1600.